

### REMARKS

This Amendment is submitted in response to the Office Action dated September 24, 2002. In the Office Action, the Patent Office withdrew the finality of the previous Office Action and entered Applicants' submission filed on April 10, 2002. Further, the Patent Office rejected Claims 21-50 as being impermissible recapture of subject matter previously surrendered by Applicants' amendment of their first application, U.S. Serial No. 08/289,257 filed August 11, 1994.

Applicants note with appreciation that the Patent Office indicated that Claims 1-20 are allowable. Further, Applicants note that, with respect to the reasons for allowance of Claims 1-20, the Patent Office states that the presence or absence of the word "analog" was not critical for the allowance, which was based on a non-obvious combination of the other limitations, particularly the recitation of integrated sound/motor/special-effect controller which uses bi-polar digital signal packets.

Further, Applicants note that in the Office Action dated June 18, 2001, the Patent Office indicated PTO-1449 forms were attached. However, Applicants did not receive PTO-1449 forms attached to the Office Action. Applicants assume that the references included in the Information Disclosure Statements, Paper Nos. 4 and 8, were reviewed and considered by the Patent Office and respectfully requests the Patent Office to forward the PTO-1449 forms indicative of the same. Notice to that effect is requested.

By the present Amendment, Applicants added Claims 51-56. Applicants submit that the application is in condition for allowance for the reasons that follow.

In the Office Action, the Patent Office rejected new Claims 21-50 under 35 U.S.C. §251 alleging improper recapture of claimed subject matter deliberately surrendered in the application for patent upon which the present reissue is based. The Patent Office alleges that neither the sole new independent Claim 21 nor dependent Claims 22-50 include all of the limitations cited in the reasons for allowance in the CIP application under Allowable Subject Matter. Specifically, the Patent Office alleges "independent Claim 21 does not recite 'an integrated sound, motor, and special effects controller', nor a controller 'controlled by a bi-polar digital signal', nor 'a controller ...recalling the sound effects of either one or a plurality of sound effects in a predetermined sequence or a random sequence' by means of a bi-polar digital signal, which combined limitation, newly recited in the CIP application, were part of the reasons for making Claim 1 allowable. Further, the Patent Office alleges that none of the dependent claims, Claims 22-50, cures this defect.

The Patent Office alleges that because new Claim 21 does not include all of the limitations cited in the reasons for allowance under the Allowable Subject Matter, and these limitations were presented/argued/stated in the original application to make the claims allowable for the Patent, the omitted limitations relate to subject matter previously surrendered by Applicants and impermissible recapture exits. Applicants submit that Claims 21-50

and any other claims of this reissued application are not required to include the limitations cited in the reasons for allowance under the Allowable Subject Matter for Claims 1-20. Claims 21-50 include patentable subject matter distinct from Claims 1-20 that was NOT surrendered in any previous application.

Further, Applicants respectfully submit that the omitted limitations in Applicants' first application, U.S. Serial No. 08/289,257, filed August 11, 1994 (hereinafter the '257 application) do NOT relate to the subject matter of new Claim 21. Accordingly, the subject matter of new Claim 21 was not presented/argued/stated in the original application.

In response to the Office Action dated August 26, 1996, for Applicants' first application in the chain, the '257 application, Applicants amended independent Claim 1. Claim 1 of the '257 application was amended to require, in part, a system for recording sounds and playing back recorded sounds without the use of any digital to analog or analog to digital conversion and an asynchronous enabling means actuating the playback of the at least one non-digitally stored and recalled characteristic sound from the sound module means (emphasis identifies amendment to Claim 1 of the '257 application).

Applicants submit the amendment to Claim 1 of the '257 application was not a surrender of subject matter as presented and defined by Claims 21-50 of the present reissue application. Applicants respectfully submit that the subject matter defined by Claim 21 was not included in Claim 1 of the '257 application and, therefore, could not have been surrendered in the application for

patent upon which the present reissue application is based. Thus, Claim 21 does not claim subject matter deliberately surrendered in the application for patent upon which the present reissue application is based.

More specifically, independent Claim 21 requires a sound reproducing system for a model train traveling on a plurality of rails that uses an amplified digital control signal for propulsion and control. The system of Claim 21 comprises a sound unit, a memory within the sound unit and a controller connected to the memory. The memory stores a plurality of sound effects at addresses wherein the sound effects contain multiple samples that emulate a train locomotive at various conditions. The memory has an analog wave form representing sound effects of a locomotive at various conditions and work loads or a digital representation of the analog wave form that represents a plurality of sound effects of a locomotive at various conditions and work loads. Further, the controller connected to the memory recalls at least one of the sound effects wherein the controller is controlled by a digital signal.

Nowhere does independent Claim 21 require digital to analog or analog to digital conversion nor does Claim 21 require playback of at least one non-digitally stored and recalled characteristic sound from the sound module means. In fact, Applicants submit the subject matter previously allegedly surrendered is NOT included in independent Claim 21 of the present reissue application.

Further, Applicants submit Claim 15 of the parent (CIP) patent requires a plurality of digitized sounds that are controlled by the

controller that receives a bi-polar digital signal. Independent Claim 21 further defines the subject matter of Claim 15 of the parent (CIP) patent and does NOT recapture surrendered subject matter.

Moreover, the original patent failed to claim in the '257 application upon which the present reissue application is based, and as now defined in independent Claim 21, a memory storing a plurality of sound effects at addresses wherein the sound effects contain multiple samples that emulate a train locomotive at various conditions and further wherein the memory has an analog wave form or a digital representation of the analog wave form representing sound effects of a locomotive at various conditions and work loads. Further, the '257 application fails to claim a controller connected to the memory for recalling the sound effects wherein the controller is controlled by a digital signal. Applicants failed to claim and/or appreciate that they were entitled to claims of this scope. Accordingly, Applicants are not attempting to recapture previously claimed subject matter as alleged by the Patent Office.

In view of the foregoing, the rejection under 35 U.S.C. §251 has been overcome. Applicants submit that independent Claim 21 is in allowable form. Notice to that effect is requested.

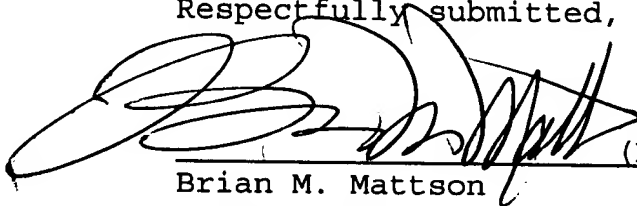
In addition, Applicants added Claims 51-56 to include independent Claim 54 and dependent Claims 51-53 and 55-56 to include the limitations identified in the reasons for allowance under allowable subject matter as suggested by the Patent Office. More specifically, Claim 51 requires an integrated sound, motor, and special effects controller; Claim 52 requires a controller

controlled by a bi-polar digital signal; and Claim 53 requires a controller recalling the sound effects of either one or a plurality of sound effects in a predetermined sequence or a random sequence by means of a bi-polar digital signal. Claim 54 requires the limitations of Claim 21 and incorporates Claims 51-53. Claim 55 requires the plurality of sound effects to be analog. Claim 56 requires the plurality of sound effects to be digital.

Claims 22-53 depend from Claim 21 and Claims 55-56 depend from Claim 54. These claims are further believed allowable over the references of record for the same reasons set forth with respect to their parent claim since each sets forth additional novel elements of Applicants' invention.

In view of the foregoing remarks and amendments, Applicants respectfully submit that all of the claims in the application are in allowable form and that the application is in condition for allowance. If, however, any outstanding issues remain, Applicants urge the Patent Office to telephone Applicants' attorney so that the same may be resolved and the application expedited to issue. Applicants request the Patent Office to indicate all claims as allowable and to pass the application to issue.

Respectfully submitted,



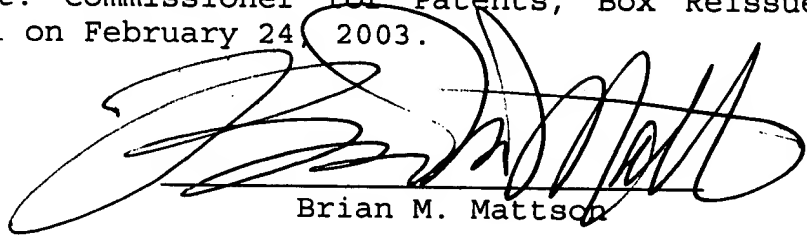
(Reg. No. 35,018)

Brian M. Mattson  
Patents+TMS  
A Professional Corporation  
1914 North Milwaukee Avenue  
Chicago, IL 60647  
773/772-6009  
Attorney for Applicants



CERTIFICATE OF MAILING

I hereby certify that this **Amendment** is being deposited with the United States Postal Service as First Class mail in an envelope addressed to the Asst. Commissioner for Patents, Box Reissue, Washington, D.C. 20231 on February 24, 2003.



Brian M. Mattson



VERSION WITH MARKINGS TO SHOW CHANGES MADE  
IN THE CLAIMS

Please add Claims 51-56 as follows:

51. The system of Claim 21 wherein the controller is an integrated sound, motor, and special effects controller.

52. The system of Claim 21 wherein the controller is controlled by a bi-polar digital signal.

53. The system of Claim 21 wherein the controller recalls the sound effects of either one or a plurality of sound effects in a predetermined sequence or a random sequence by means of a bi-polar digital signal.

54. A sound reproducing system for a model train traveling on a plurality of rails that uses an amplified digital control signal for propulsion and control, the system comprising:

a sound unit;

a memory within the sound unit wherein the memory stores a plurality of sound effects at addresses wherein the sound effects contain multiple samples that emulate a train locomotive at various conditions; and



a controller connected to the memory for recalling at least one of the sound effects wherein the controller is an integrated sound, motor, and special effects controller and further wherein the controller is controlled by a bi-polar digital signal and further wherein the controller recalls the sound effects of either one or the plurality of sound effects in a predetermined sequence or a random sequence by means of the bi-polar digital signal.

55. The system of Claim 54 wherein the plurality of sound effects are analog.

56. The system of Claim 54 wherein the plurality of sound effects are digital.